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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK J. HARRIS

Appeal 2008-4935
Application 10/018,378
Technology Center 2600

Decided: December 8, 2008

Before JOSEPH F. RUGGIERO, CARLA M. KRIVAK
and, ELENI MANTIS MERCADER *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

Appellant's claimed invention is directed to converting a telephone number identifying a device into a multi-level domain name to enable devices on a network to communicate (Spec. 1:3-6).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method comprising:

receiving a telephone number portion identifying a device;

converting the telephone number portion into a multiple level domain name identifying the device over a network, the multiple level domain name comprising a plurality of domains corresponding to the telephone number portion and a base portion, where the plurality of domains corresponding to the telephone number portion are arranged in an order corresponding to the telephone number portion; and

establishing communication with the device via the multiple level domain name over the network.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Andersen	US 5,974,453	Oct. 26, 1999

The following rejection is before us for review:

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Andersen.

Independent claims 1, 7 and 10 and dependent claims 2-6, 8-9, and 11-14 were argued as a group with claim 1 as representative (Br. 5-8).[1] Accordingly, claims 2-14 stand or fall with claim 1. *See* 37 C.F.R. § 41.37 (c)(1)(vii) (2004).

OBVIOUSNESS

ISSUE

Appellant contends Andersen describes translating a telephone number, into a network address but "reverses" components of the telephone number so that a telephone number arranged with the most general geographic identifier to the "left" (e.g. country code, area code, exchange, and number) becomes geographic general toward the "right" (Br. 5). Appellant asserts the telephone elements are scrambled (Br. 5). Appellant further contends Andersen does not mention the possibility or desirability of the network address being maintained in an order corresponding to the telephone number (Br. 7).

The Examiner responds that a "reverse order" is still an "order" as claimed and the elements of the phone number are not scrambled (Ans. 5). Furthermore,

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[1] Only arguments made by Appellant have been considered in this decision. Arguments which Appellant could have made but did not to make in the Brief have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

the Examiner responds that the argued but not claimed "direct" and "exact" order is obviously desirable because it requires "less" re-arrangement (Ans. 6).

Has the Appellant shown the Examiner erred by determining that Andersen teaches arranging the plurality of domains corresponding to the telephone number portion "in an order corresponding to the telephone number portion" as claimed?

FINDINGS OF FACT

The relevant fact includes the following:

1. Andersen teaches arranging the plurality of domains corresponding to the telephone number portion in a reverse order corresponding to the telephone number portions (in Fig. 4 element 400 showing phone number 011-123/456-7890 and element 405 showing reverse order corresponding to the telephone number portions 7890.456.123.011.ULS.DIR-CON.COM).
2. Appellant does not dispute that Andersen "reverses" the order of the telephone number portions (Br. 5).
3. Appellant's Specification discloses that "the received telephone number may be rearranged in any sequence without materially affecting the scope of the subject invention so long as all are likewise arranged or determinable" (Spec. 7:27-30).

PRINCIPLES OF LAW

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, citing *In re Kahn*, 441 F.3d at 988,

stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

"The diversity of inventive pursuits and of modern technology counsels against confining the obviousness analysis by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasizing the importance of published articles and the explicit content of issued patents." *Id.* at 1731-32. "Rigid preventative rules that deny factfinders recourse to common sense are neither necessary . . . nor consistent with" our case law. *Id.* at 1742-43.

The claim terms should be given their broadest reasonable meaning in their ordinary usage as such claim terms would be understood by one skilled in the art by way of definitions and the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

> The claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument' . . . consisting principally of a specification that concludes with the claims. For that reason, claims 'must be read in view of the specification, of which they are a part.' . . . . [T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005).

During ex parte prosecution, claims must be interpreted as broadly as their

terms reasonably allow since Appellants have the ability during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

ANALYSIS

Has the Appellant shown that the Examiner erred by determining that Andersen teaches arranging the plurality of domains corresponding to the telephone number portion "in an order corresponding to the telephone number portion" as claimed?

Andersen teaches arranging the plurality of domains corresponding to the telephone number portions in a reverse order corresponding to the telephone number portions (Finding of Fact 1). Appellant does not dispute that Andersen "reverses" the order of the telephone number portions (Finding of Fact 2). Appellant's Specification discloses that "the received telephone number may be rearranged in any sequence without materially affecting the scope of the subject invention so long as all are likewise arranged or determinable" (Finding of Fact 3).

The claimed term "an order" does not preclude a reversed "order" which also constitutes a type of "an order." Furthermore, as stated *supra*, the Specification is the single best guide to the meaning of a disputed term, and thus, the disputed term "order" includes the meaning of a "reversed order" because the rearrangement is in a "reverse" sequence which is "likewise arranged or determinable" (i.e., in a reverse order). *Phillips v. AWH Corp.*, 415 F.3d 1303,

1315 (Fed. Cir. 2005).

Furthermore, as the Examiner determined, even if "an order" constituted a "direct" or "exact" order as argued but not claimed, such a modification would have been obvious to one skilled in the art for the advantage of requiring less re-arrangement. As stated *supra*, "[t]he diversity of inventive pursuits and of modern technology counsels against confining the obviousness analysis by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasizing the importance of published articles and the explicit content of issued patents." *KSR v. Teleflex*, 127 S. Ct. at 1731-32. Furthermore, rigid preventative rules that deny factfinders recourse to common sense (i.e., "direct" or "exact" order requires less re-arrangement) are neither necessary nor consistent with our case law. *Id.* 1742-43.

CONCLUSION

The Appellant has not shown the Examiner erred by determining that Andersen teaches arranging the plurality of domains corresponding to the telephone number portion "in an order corresponding to the telephone number portion" as claimed.

ORDER

The decision of the Examiner to reject claims 1-14 under 35 U.S.C. § 103(a) as being obvious over Andersen is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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